


Appl. No. : 09/147,861  
Filed : March 17, 1999

 layer of a material having a refractive index of 1.9 to 3.1, the second coating layer of a material having a refractive index of 1.3 to 1.8; and  
applying the coated powder on the surface.

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**REMARKS**

Claim 7 has been amended. Claims 1-7 are now pending in this application. Claim 7 has been amended for clarity as suggested by the Examiner. Accordingly, the amendment does not constitute the addition of new matter. Applicant respectfully requests the entry of the amendment and reconsideration of the application in view of the amendment and the following remarks.

The specific changes to the specification and the amended claims are shown on a separate set of pages attaches hereto and entitled **VERSION WITH MARKINGS TO SHOW CHANGES MADE**, which follows the signature page of this Amendment. On this set of pages, insertions are underlined and deletions are struck through.

**Rejection under 35 U.S.C. § 112, second paragraph**

Claim 7 stands rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 7 has been amended as suggested by the Examiner.

Reconsideration and withdrawal of this ground of rejection is respectfully requested.

**Rejection under 35 U.S.C. § 102(b)**

Claims 1-7 stand rejected as anticipated by Farer et al.

The Examiner asserts that Farer et al. teach coated particles where the first coating material is a coupling agent selected from the group consisting of silanes and titanates applied to a polyvinylidene copolymer base particle and a second coating. The second coating is preferably boron nitrate, but Farer et al. provide a list of alternate coatings which include silicone powders, zirconium dioxide and titanium dioxide and combinations.

The present invention is a coated powder with a three-part structure: powder as a core and two coating layers on the core. Each of the three parts is defined to be a material having a certain specified refractive index. The combination of the three refractive indices of the parts defines the characteristics of the claimed coated powder. Farer et al. fail to anticipate the claimed invention

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because Farer et al. do not disclose a coated powder which is defined by a combination of the refractive indices of the component parts.

The combination specifically disclosed by Farer et al. is "where boron nitride is coated onto hollow polyvinylidene chloride copolymer spheres treated with a coupling agent" (col. 3, lines 58-60). The specific combination taught by Farer et al. clearly does not anticipate Applicants' claims. Although the Examiner cites the section at column 3, line 57 to column 4, line 13, as teaching other suitable coatings, the cited section is merely a laundry list of compounds with diverse structural features and chemical properties and does not teach the specific combination claimed by Applicants. Importantly, there is no disclosure of the refractive index of these compounds. Consequently, there is no teaching in Farer et al. on combinations that would anticipate Applicants' claimed invention.

In any case, Farer et al. do not teach the method steps recited in claims 6 and 7. Consequently, Farer et al. cannot anticipate these claims.

In view of Applicants' arguments, reconsideration and withdrawal is respectfully requested.

**Rejection under 35 U.S.C. § 103(a)**

Claims 1-7 stand rejected as being unpatentable over Farer et al.

The Examiner asserts that Farer et al. teach the same components as Applicants and that the refractive index is inherent to these components. The Examiner further asserts that while boron nitrate is acceptable, other coatings are acceptable such as silicone powders, zirconium dioxide, and titanium dioxide and combinations.

In response, Farer et al. do not disclose a specific combination of each particular refractive index of each part of the three parts of the structure of the claimed coated powder. Consequently one of ordinary skill in the art would not have a reasonable expectation of obtaining a coated powder with the same properties as Applicants' claimed coated powders based upon the teaching of Farer et al. The Examiner again argues that, while the preferred embodiment is particles coated with boron nitrate, other suitable coatings are acceptable and cites a list of compounds provided at col. 3, lines 57 to col. 4, line 13. Again, this teaching does not provide sufficient guidance to one of ordinary skill in the art to achieve Applicants' claimed invention with a reasonable expectation of success as the cited section is merely a laundry list of compounds commonly used in cosmetic preparations. Some motivation to select the claimed

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species or subgenus must be taught by the prior art. See e.g. Deuel 51 F.3d at 1558-59,34 U.S.P.Q.2d at 1215. Such motivation is lacking in the cited reference.

Furthermore, the cited list is relatively long. The compounds listed do not appear to share structural features or chemical properties and no such features or properties are pointed out in the reference. Importantly, there is no teaching on relevant physical properties such as refractive index. The cited reference does not provide sufficient guidance such that one of ordinary skill in the art could achieve the claimed coated powder.

Consequently, the reference provides no teaching or suggestion that would lead one of ordinary skill in the art to choose compounds from the cited list which would lead to the claimed combination of components. It is respectfully submitted that one of ordinary skill in the art would not be motivated to pick through the list provided by Farer et al. for compounds with the desired refractive index of 1.3 to 1.9 to provide the outer coating layer (C) of claim 1 without the teaching of the present disclosure. However the use of Applicants' own disclosure to arrive at the claimed invention constitutes impermissible hindsight. As the Federal Circuit observed in Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 217 U.S.P.Q. 193 (Fed. Cir. 1983):

The question of nonobviousness is a simple one to ask, but difficult to answer...The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the references in the right way so as to achieve the result of the claims in suit.

In conclusion, there is insufficient guidance in Farer et al. for one of ordinary skill in the art to arrive at the claimed combination of components. Furthermore, there is no teaching or suggestion in the Farer et al. reference to practice the method steps of Applicants' claims 6 and 7.

In view of Applicants' arguments, reconsideration and withdrawal of this ground or rejection is respectfully requested.

#### **CONCLUSION**

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

Claim 7 has been amended as follows:

Claim 7. (Amended) A method of applying natural coloring on a surface by using a coated powder, comprising the steps of:

designing composition of the coated powder wherein a core powder is coated with at least first and second coating layers, by determining a quantity of the first coating layer and a quantity of the second coating layer based on a correlation between the degree of linear transmission and the quantity of each layer, to impart a predetermined degree of linear light transmission, said coated powder permitting nearly 100% total light transmission, the core powder having a refractive index of 1.3 to 1.8, the first coating layer of a material having a refractive index of 1.9 to 3.1, the second coating layer of a material having a refractive index of 1.3 to 1.8; and

applying the coated powder on the surface.

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